

REMARKS:

Claims 1-28 are currently pending in the application. Claims 1-28 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,460,038 to Khan et al. ("Khan") in view of U.S. Patent No. 5,946,665 to Suzuki et al. ("Suzuki").

By this Amendment, independent claims 1, 11, and 20 and dependent claim 5 have been amended to more particularly point out and distinctly claim the Applicants invention. By making these amendments, the Applicants make no admission concerning the merits of the Examiner's rejection, and respectfully deny any statement or averment of the Examiner not specifically addressed. Particularly, the Applicants reserve the right to file additional claims in this Application or through a continuation patent application of substantially the same scope of originally filed claims 1-28. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-28 stand rejected under 35 U.S.C. § 103(a) over Khan in view of Suzuki.

Although the Applicants believe claims 1-28 are directed to patentable subject matter without amendment, the Applicants have amended independent claims 1, 11, and 20 and dependent claim 5 to more particularly point out and distinctly claim the Applicants invention. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicants respectfully submit that Khan or Suzuki either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 1-28. Thus, the Applicants respectfully traverse the Examiners obvious rejection of claims 1-28 under 35 U.S.C. § 103(a) over the proposed combination of Khan and Suzuki either individually or in combination.

The Proposed Khan-Suzuki Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims

For example, with respect to amended independent claim 1, this claim recites:

A global content directory for a distributed plurality of seller databases, each seller database being associated with a corresponding seller and distinct from other seller databases in the distributed plurality of seller databases, the global content directory comprising:

a directory structure comprising a plurality of product classes organized using a hierarchical, object-oriented classification system, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class;

one or more pointers associated with each product class in the plurality of product classes, each pointer identifying the seller database in the distributed plurality of seller databases in which product data enabling a product transaction is stored for products associated with the product class, the seller database identified by the pointer being associated with its corresponding seller and being distinct from the other seller databases in the distributed plurality of seller databases; and

a search interface operable to communicate, in response to a selection of a product class by a user of the global content directory, **a search query for product data to the one or more seller databases identified by the one or more pointers associated with the selected product class, each seller database being associated with its corresponding seller and distinct from the other seller databases in the plurality of seller databases.** (Emphasis Added).

Amended independent claims 11 and 20 recite similar limitations. Khan or Suzuki either individually or in combination, fail to disclose each and every limitation of independent claims 1, 11, and 20.

The Applicants respectfully submit that Khan has nothing to do with amended independent claim 1 limitations regarding a global content directory for a distributed plurality of seller databases comprising a directory structure, pointers associated with a plurality of product classes, and a search interface. Rather Khan merely discloses a system for programming an internet browser bookmark for delivering information to a user. (Abstract). Although Khan discloses a plurality of bookmarks (Figure 10), Khan does not disclose a pointer identifying a single bookmark, a plurality of bookmarks, or even a bookmark associated with its corresponding seller distinct from the other bookmarks in the

plurality of bookmarks. Thus, Khan cannot provide a global content directory for a distributed plurality of seller databases, a directory structure comprising a plurality of product classes organized using a hierarchical, object-oriented classification system, or even pointers associated with a plurality of product classes identifying the seller database in the distributed plurality of seller databases in which product data enabling a product transaction is stored for products associated with the product class.

The Applicants further submit that the Office Action acknowledges, and the Applicants agree, that Khan fails to disclose the emphasized limitations noted above in amended independent claim 1. Specifically the Examiner acknowledges that Khan fails to disclose the use of a search interface operable to communicate a search query for product data to one or more seller databases identified by the one or more pointers associated with the selected product class. (30 September 2005 Final Office Action, Page 3). However, the Examiner asserts that the cited portions of Suzuki disclose the acknowledged shortcomings in Khan. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in Suzuki.

The Applicants further submit that Suzuki has nothing to do with amended independent claim 1 limitations regarding a global content directory for a distributed plurality of seller databases comprising a directory structure and pointers associated with a plurality of product classes and in particular Suzuki has nothing to do with a search interface operable to communicate, in response to a selection of a product class by a user of the global content directory, a search query for product data to the seller databases identified by the pointers associated with the selected product class. Rather Suzuki discloses a search server associated with an online shopping system. (Abstract). Although Suzuki discloses a search server, the search server is merely an online shopping system using a communications network to provide online shopping information for a customer. Suzuki fails to disclose, teach, or suggest that the online shopping system of Suzuki is operable to communicate with a search query for product data identified by pointers associated with the selected product class, or even any online shopping information for a customer. Thus, Suzuki cannot provide a global content directory for a distributed plurality of seller databases comprising a directory

structure, pointers associated with a plurality of product classes, or even a search interface, since Suzuki does not even provide for a search interface, receiving a selection of a product class by a user of the global content directory, or even communicating a search query for product data to seller databases identified by pointers associated with the selected product class.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Khan and Suzuki, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine Khan and Suzuki as proposed. The Office Action merely states that it is well known in the art to use a search interface operable to communicate a search query for product data to one or more seller databases. (30 September 2005 Final Office Action, Page 3). The Applicants respectfully disagree.

The Applicants further submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in Khan or Suzuki, either individually or in combination. The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a search interface, as taught by Suzuki, into a global directory as described by Khan. (30 September 2005 Final Office Action, Page 3). The Applicants respectfully request the Examiner to point to the portions of Khan or Suzuki which contain the teaching, suggestion, or motivation to combine Khan and Suzuki for the Examiner's stated purported advantage. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the **prior art must disclose each and every element of the claimed invention**, and that any motivation to combine or modify the prior art **must be based upon a suggestion in the prior art**. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

(Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of Khan and Suzuki to render obvious the Applicants claimed invention. The Examiner's conclusory statements that "it is well known in the art to use a search interface operable to communicate a search query for product data to one or more seller databases" and that it would have been obvious "in order to search the different databases" does not adequately address the issue of motivation to combine. (30 September 2005 Final Office Action, Page 3). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of Khan or Suzuki, either individually or in combination.

The Proposed Khan-Suzuki Combination is Improper Under MPEP § 706.02(j) For Applicants Amended Independent Claims 1, 11, and 20 and Dependent Claims 7-10, 16-19, and 25-28.

The Applicants respectfully submit that the rejection of amended independent claims 1, 11, and 20 and dependent claims 7-10, 16-19, and 25-28 are improper under 35 U.S.C. § 103(a) over Khan in view of Suzuki, because the Examiner's initial burden of proof has not been satisfied. Furthermore, the Applicants respectfully traverse the rejection of amended independent claims 1, 11, and 20 and dependent claims 7-10, 16-19, and 25-28 because the Examiner has not properly complied with MPEP § 706.02(j).

After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with **reference to the relevant column or page number(s) and line number(s) where appropriate**,

(B) the difference or **differences in the claim over the applied reference(s)**,

(C) the **proposed modification of the applied reference(s)** necessary to arrive at the claimed subject matter, and

(D) an **explanation why one of ordinary skill** in the art at the time the invention was made **would have been motivated to make the proposed modification**. (MPEP § 706.02(j)). (Emphasis Added).

The Applicants further submit that the Examiner has not set forth: (1) the relevant teachings of Suzuki **including any references to the relevant column and line numbers of Suzuki**; (2) asserted any argument or remarks regarding the differences in the Applicants claims over Suzuki; (3) asserted any proposed modifications of Suzuki to arrive at the Applicants claimed invention; or (4) asserted any explanation why one of ordinary skill would have been motivated to make the proposed modifications. In addition to the above requirements for a proper 35 U.S.C. 103 rejection, the MPEP provides three basic criteria, which the Examiner must meet in order to establish a *prima facie* case of obviousness. (See MPEP § 706.02(j)). First, there must be some suggestion or motivation, either in Khan or Suzuki, or in the knowledge generally available to one of ordinary skill in the art, to modify Khan and Suzuki. Second, there must be a reasonable expectation of success. Finally, Khan and Suzuki, either individually or in combination, must teach or suggest all the Applicants claim limitations. **The teaching or suggestion to make the Khan and Suzuki combination and the reasonable expectation of success must both be found in Khan or Suzuki and not based on Applicants disclosure.** *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis Added).

The Applicants still further submit that the MPEP clearly states that the “initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done.” (MPEP § 706.02(j)). “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). In the subject Application, the Examiner has not shown the Applicants claimed invention to be expressly or impliedly

suggested in the Khan or Suzuki reference nor has the Examiner presented a convincing line of reasoning, let alone any reasoning, why the artisan would have found the Applicants claimed invention to be obvious in view of Khan or Suzuki.

The MPEP further states that “it is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” (MPEP § 706.02(j)). Thus, if the Examiner continues to maintain the rejection to independent claims 1, 11, and 20 and dependent claims 7-10, 16-19, and 25-28 under 35 U.S.C. § 103(a) based on the proposed combination of Khan and Suzuki, the Applicants respectfully request that the Examiner provide a proper response as necessitated by MPEP § 706.02(j).

For at least the reasons set forth herein, the Applicants respectfully request that the rejection of amended independent claims 1, 11, and 20 and dependent claims 7-10, 16-19, and 25-28 under 35 U.S.C. § 103(a) be reconsidered and that independent claims 1, 11, and 20 and dependent claims 7-10, 16-19, and 25-28 be allowed.

The Proposed Khan-Suzuki-Official-Notice Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims

The Applicants respectfully submit that Khan, Suzuki, or the Examiner’s purported Official Notice, either individually or in combination, fails to disclose, teach, or suggest each and every element of amended independent claims 1, 11, and 20. Thus, the Applicants respectfully traverse the Examiner’s obvious rejection of amended independent claims 1, 11, and 20 under 35 U.S.C. § 103(a) over the proposed combination of Khan, Suzuki, and the Examiner’s purported Official Notice, either individually or in combination.

The Applicants further submit that the Applicants are confused as to what the Examiner is intending to teach by the purported Official Notice or even the extent in which the Examiner is taking Official Notice. The Applicants respectfully request clarification as to the subject matter for which the Examiner is taking Official Notice. The Examiner alleges that Suzuki teaches that “it is well known in the art the [sic] use a search interface (2) operable to communicate a search query for product data to one or more seller databases.” (30 September 2005 Final Office Action, Page 3). The Applicants

respectfully traverse the purported Official Notice because the asserted facts, as best understood by the Applicants, are not supported by substantial documentary evidence or any type of documentary evidence and appear to be the Examiner's opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner's conclusion. (See MPEP § 2144.03). The Applicants respectfully request the Examiner to produce authority for the Examiner's purported Official Notice.

Only "in limited circumstances," is it "appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection". (MPEP § 2144.03). "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be 'capable of such instant and unquestionable demonstration as to defy the dispute' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." (MPEP § 2144.03(A)). (Emphasis Added).

"It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002)." (MPEP § 2144.03(A)).

"Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that **general conclusions concerning what is "basic knowledge" or "common sense" to one of**

ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” (MPEP § 2144.03(B)). (Emphasis Added).

The Applicants respectfully submit that the Office Action provides no documentary evidence to support the purported Official Notice taken by the Examiner, yet the asserted facts are not capable of “instant and unquestionable” demonstration as being well-known. The Applicants further submit that the Applicants have adequately traversed the Examiner’s assertion of Official Notice and direct the Examiner’s attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of amended independent claims 1, 11, and 20 based on the Examiner’s Official Notice, the Applicants respectfully request that the Examiner provide documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Applicants further request that the Examiner provide an Affidavit or Declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C).

In addition, the Applicants respectfully point the Examiner to the pertinent sections of the MPEP, directly on point to determine whether the next Office Action should be made Final. In particular, the Applicants respectfully direct the Examiner's attention to MPEP § 2144.03(D), which states:

If the examiner adds a reference in the next Office action after applicant's rebuttal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final. If the newly cited reference is added for reasons other than to support the prior common knowledge statement and a new ground of rejection is introduced by the examiner that is not necessitated by applicant's amendment of the claims, the rejection may not be made final. (MPEP § 2144.03(D)).

The Proposed Khan-Suzuki Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Dependent Claims 2, 12, and 21.

The Applicants respectfully submit that Khan or Suzuki, either individually or in combination, fails to disclose, teach, or suggest each and every element of dependent claims 2, 12, and 21. Thus, the Applicants respectfully traverse the Examiner's obvious rejection of dependent claims 2, 12, and 21 under 35 U.S.C. § 103(a) over the proposed combination of Khan and Suzuki, either individually or in combination.

For example, with respect to dependent claim 2, this claim recites:

2. The directory of Claim 1, wherein **the directory structure comprises a lightweight directory access protocol (LDAP) directory.** (Emphasis Added).

Dependent claims 12 and 21 recite similar limitations. Khan or Suzuki, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 2, 12, and 21.

The Applicants respectfully submit that Khan has nothing to do with dependent claim 2 limitations regarding a global content directory for a distributed plurality of seller

databases comprising a directory structure, pointers associated with a plurality of product classes, and a search interface and in particular Khan has nothing to do with a global content directory comprising a lightweight directory access protocol directory. In fact, the only argument asserted by the Examiner is a conclusory remark stating "Kahn discloses the use of an access protocol." (30 September 2005 Final Office Action, Page 3). The Applicants respectfully disagree.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Khan and Suzuki, either individually or in combination. The Applicants further submit that the allegation in the present Office Action that Khan discloses all of the claimed features of dependent claim 2 is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how Khan is considered to anticipate all of the limitations in dependent claim 2. A prior art reference anticipates the claimed invention only if each and every element of a claimed invention is identically shown in that single reference. MPEP § 2131. Applicants respectfully point out that "it is incumbent upon the [E]xaminer to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicants respectfully request the Examiner to point to the portions of Khan or Suzuki which contain the teaching, suggestion, or motivation to combine Khan and Suzuki for the Examiner's stated purported advantage. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the **prior art must disclose each and every element of the claimed invention**, and that any motivation to combine or modify the prior art **must be based upon a suggestion in the prior art**. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and

combination of Khan and Suzuki to render obvious the Applicants claimed invention. The Examiner's conclusory statement that "Kahn discloses the use of an access protocol" does not adequately address the issue of motivation to combine. (30 September 2005 Final Office Action, Page 3). In addition, the Office Action has failed to establish a *prima facie* case of anticipation in dependent claim 2 with respect to Khan because Khan fails to identically disclose each and every element of the Applicants claimed invention, arranged as they are in Applicants claim.

The Proposed Khan-Suzuki Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Dependent Claims 3, 13, and 22.

The Applicants respectfully submit that Khan or Suzuki, either individually or in combination, fails to disclose, teach, or suggest each and every element of dependent claims 3, 13, and 22. Thus, the Applicants respectfully traverse the Examiner's obvious rejection of dependent claims 3, 13, and 22 under 35 U.S.C. § 103(a) over the proposed combination of Khan and Suzuki, either individually or in combination.

For example, with respect to dependent claim 3, this claim recites:

3. The directory of Claim 1, wherein the **directory structure is distributed between a plurality of computers**. (Emphasis Added).

Dependent claims 13 and 22 recite similar limitations. Khan or Suzuki, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 3, 13, and 22.

The Applicants respectfully submit that Khan has nothing to do with dependent claim 3 limitations regarding a global content directory for a distributed plurality of seller databases comprising a directory structure, pointers associated with a plurality of product classes, and a search interface and in particular Khan has nothing to do with a global content directory structure distributed between a plurality of computers. In fact, the only argument asserted by the Examiner is a conclusory remark stating "Kahn discloses the directory structure is distributed between pluralities of computers." (30 September 2005 Final Office Action, Page 3). The Applicants respectfully disagree.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Khan and Suzuki, either individually or in combination. The Applicants further submit that the allegation in the present Office Action that Khan discloses all of the claimed features of dependent claim 3 is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how Khan is considered to anticipate all of the limitations in dependent claim 3. A prior art reference anticipates the claimed invention only if each and every element of a claimed invention is identically shown in that single reference. MPEP § 2131. Applicants respectfully point out that "it is incumbent upon the [E]xaminer to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicants respectfully request the Examiner to point to the portions of Khan or Suzuki which contain the teaching, suggestion, or motivation to combine Khan and Suzuki for the Examiner's stated purported advantage. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the **prior art must disclose each and every element of the claimed invention**, and that any motivation to combine or modify the prior art **must be based upon a suggestion in the prior art**. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of Khan and Suzuki to render obvious the Applicants claimed invention. The Examiner's conclusory statement that "Kahn discloses the directory structure is distributed between pluralities of computers" does not adequately address the issue of motivation to combine. (30 September 2005 Final Office Action, Page 3). In addition, the Office Action has failed to establish a *prima facie* case of anticipation in dependent claim 3 with respect to Khan because Khan fails to identically disclose each and every element of the Applicants claimed invention, arranged as they are in Applicants claim.

The Proposed Khan-Suzuki Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Dependent Claims 4, 14, and 23.

The Applicants respectfully submit that Khan or Suzuki, either individually or in combination, fails to disclose, teach, or suggest each and every element of dependent claims 4, 14, and 23. Thus, the Applicants respectfully traverse the Examiner's obvious rejection of dependent claims 4, 14, and 23 under 35 U.S.C. § 103(a) over the proposed combination of Khan and Suzuki, either individually or in combination.

For example, with respect to dependent claim 4, this claim recites:

4. The directory of Claim 1, wherein **the directory is coupled to the seller databases using the Internet.** (Emphasis Added).

Dependent claims 14 and 23 recite similar limitations. Khan or Suzuki, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 4, 14, and 23.

The Applicants respectfully submit that Khan has nothing to do with dependent claim 4 limitations regarding a global content directory for a distributed plurality of seller databases comprising a directory structure, pointers associated with a plurality of product classes, and a search interface and in particular Khan has nothing to do with a global content directory structure coupled to the seller databases using the Internet. In fact, the only argument asserted by the Examiner is a conclusory remark stating "Kahn discloses the use of the Internet." (30 September 2005 Final Office Action, Page 3). The Applicants respectfully disagree.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Khan and Suzuki, either individually or in combination. The Applicants further submit that the allegation in the present Office Action that Khan discloses all of the claimed features of dependent claim 4 is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how Khan is considered to anticipate all of the limitations in dependent claim 4. A prior art reference anticipates the claimed invention

only if each and every element of a claimed invention is identically shown in that single reference. MPEP § 2131. Applicants respectfully point out that "it is incumbent upon the [E]xaminer to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicants respectfully request the Examiner to point to the portions of Khan or Suzuki which contain the teaching, suggestion, or motivation to combine Khan and Suzuki for the Examiner's stated purported advantage. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the **prior art must disclose each and every element of the claimed invention**, and that any motivation to combine or modify the prior art **must be based upon a suggestion in the prior art**. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of Khan and Suzuki to render obvious the Applicants claimed invention. The Examiner's conclusory statement that "Kahn discloses the use of the Internet" does not adequately address the issue of motivation to combine. (30 September 2005 Final Office Action, Page 3). In addition, the Office Action has failed to establish a *prima facie* case of anticipation in dependent claim 4 with respect to Khan because Khan fails to identically disclose each and every element of the Applicants claimed invention, arranged as they are in Applicants claim.

The Proposed Khan-Suzuki Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Dependent Claim 5.

The Applicants respectfully submit that Khan or Suzuki, either individually or in combination, fails to disclose, teach, or suggest each and every element of amended dependent claim 5. Thus, the Applicants respectfully traverse the Examiner's obvious

rejection of dependent claim 5 under 35 U.S.C. § 103(a) over the proposed combination of Khan and Suzuki, either individually or in combination.

For example, with respect to dependent claim 5, this claim recites:

5. The directory of Claim 1, further comprising one or more additional directory structures, each directory structure comprising the same classes but organized using a different hierarchical, object-oriented classification system. (Emphasis Added).

The Applicants respectfully submit that Khan has nothing to do with amended dependent claim 5 limitations regarding a global content directory for a distributed plurality of seller databases comprising a directory structure, pointers associated with a plurality of product classes, and a search interface and in particular Khan has nothing to do with a global content directory includes additional directory structures comprising the same classes but organized using a different hierarchical, object-oriented classification system. In fact, the only argument asserted by the Examiner is a conclusory remark stating "Kahn illustrates that the global content directory further includes one or more additional directory structures." (30 September 2005 Final Office Action, Page 3). The Applicants respectfully disagree.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Khan and Suzuki, either individually or in combination. The Applicants further submit that the allegation in the present Office Action that Khan discloses all of the claimed features of amended dependent claim 5 is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how Khan is considered to anticipate all of the limitations in dependent claim 5. A prior art reference anticipates the claimed invention only if each and every element of a claimed invention is identically shown in that single reference. MPEP § 2131. Applicants respectfully point out that "it is incumbent upon the [E]xaminer to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicants respectfully request the Examiner to point to

the portions of Khan or Suzuki which contain the teaching, suggestion, or motivation to combine Khan and Suzuki for the Examiner's stated purported advantage. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the **prior art must disclose each and every element of the claimed invention**, and that any motivation to combine or modify the prior art **must be based upon a suggestion in the prior art**. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of Khan and Suzuki to render obvious the Applicants claimed invention. The Examiner's conclusory statement that "Kahn illustrates that the global content directory further includes one or more additional directory structures" does not adequately address the issue of motivation to combine. (30 September 2005 Final Office Action, Page 3). In addition, the Office Action has failed to establish a *prima facie* case of anticipation in amended dependent claim 5 with respect to Khan because Khan fails to identically disclose each and every element of the Applicants claimed invention, arranged as they are in Applicants claim.

The Proposed Khan-Suzuki Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Dependent Claims 6, 15, and 24.

The Applicants respectfully submit that Khan or Suzuki, either individually or in combination, fails to disclose, teach, or suggest each and every element of dependent claims 6, 15, and 24. Thus, the Applicants respectfully traverse the Examiner's obvious rejection of dependent claims 6, 15, and 24 under 35 U.S.C. § 103(a) over the proposed combination of Khan and Suzuki, either individually or in combination.

For example, with respect to dependent claim 6, this claim recites:

6. The directory of Claim 1, wherein **the search query comprises a structured query language (SQL) query.** (Emphasis Added).

Dependent claims 15 and 24 recite similar limitations. Khan or Suzuki, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 6, 15, and 24.

The Applicants respectfully submit that Khan has nothing to do with dependent claim 6 limitations regarding a global content directory for a distributed plurality of seller databases comprising a directory structure and pointers associated with a plurality of product classes and in particular Khan has nothing to do with a search interface including a search query comprising a structured query language query. In fact, the only argument asserted by the Examiner is a conclusory remark stating "Kahn discloses the use of a structured query language." (30 September 2005 Final Office Action, Page 3). The Applicants respectfully disagree. The Applicants further submit that on the same page of the Office Action, the Examiner specifically acknowledges that Khan fails to disclose the use of a search interface operable to communicate a search query for product data to one or more seller databases identified by the one or more pointers associated with the selected product class. (30 September 2005 Final Office Action, Page 3).

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Khan and Suzuki, either individually or in combination. The Applicants further submit that the allegation in the present Office Action that Khan discloses all of the claimed features of dependent claim 6 is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how Khan is considered to anticipate all of the limitations in dependent claim 6. A prior art reference anticipates the claimed invention only if each and every element of a claimed invention is identically shown in that single reference. MPEP § 2131. Applicants respectfully point out that "it is incumbent upon the [E]xaminer to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicants respectfully request the Examiner to point to

the portions of Khan or Suzuki which contain the teaching, suggestion, or motivation to combine Khan and Suzuki for the Examiner's stated purported advantage. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the **prior art must disclose each and every element of the claimed invention**, and that any motivation to combine or modify the prior art **must be based upon a suggestion in the prior art**. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of Khan and Suzuki to render obvious the Applicants claimed invention. The Examiner's conclusory statement that "Kahn discloses the use of a structured query language" coupled with the Examiner's statement that "Khan fails to disclose the use of a search interface operable to communicate a search query for product data to one or more seller databases identified by the one or more pointers associated with the selected product class" does not adequately address the issue of motivation to combine. (30 September 2005 Final Office Action, Page 3). In addition, the Office Action has failed to establish a *prima facie* case of anticipation in dependent claim 6 with respect to Khan because, as acknowledged by the Examiner, Khan fails to identically disclose each and every element of the Applicants claimed invention, arranged as they are in Applicants claim.

The Applicants Claims are Patentable over the Proposed Khan-Suzuki Combination.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Kahn and Suzuki, either individually or in combination. As mentioned above, the Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the

invention to combine these references as proposed. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a). A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that **any motivation to combine or modify the prior art must be based upon a suggestion in the prior art**. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). **Conclusory statements** regarding common knowledge and common sense **are insufficient to support a finding of obviousness**. Id. at 1434-35. (Emphasis Added). Thus, the Office Action fails to provide proper motivation for combining the teachings of Khan or Suzuki, either individually or in combination.

The Applicants respectfully submit that amended independent claims 11 and 20 include limitations similar to those discussed above in connection with amended independent claim 1. Thus, independent claims 11 and 20 are considered patentably distinguishable over Khan, Suzuki, or the Examiners purported Official Notice for at least the reasons discussed above in connection with amended independent claim 1. With respect to dependent claims 2-10, 12-19, and 21-28: claims 2-10 depend from amended independent claim 1; claims 12-19 depend from amended independent claim 11; and claims 21-28 depend from amended independent claim 20. As mentioned above, each of amended independent claims 1, 11, and 20 are considered patentably distinguishable over the proposed combination of Khan, Suzuki, and the Examiner's Official Notice. Thus, dependent claims 2-10, 12-19, and 21-28 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicants submit that claims 1-28 are not rendered obvious by the proposed combination of Khan, Suzuki, or the Examiner's Official Notice. The Applicants further submit that claims 1-28 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 1-28 under 35 U.S.C. § 103(a) be reconsidered and that claims 1-28 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:


In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

11/18/05
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